

Attorney Docket: 01432
U.S. Application No.: 10/090,368 Examiner Genack Art Unit: 2617
Response to October 18, 2007 Final Office Action

REMARKS

In response to the Office Action dated October 18, 2007, the Assignee respectfully requests reconsideration based on the above amendments and on the following remarks.

Claims 1-3 and 6-35 are pending in this application. Claims 4-5 have been previously canceled without prejudice or disclaimer.

Rejection of Claims under § 103 (a) over *Smith* and *McKendry*

Claims 1-3, 9, 12-15, 18-22, 26, 29-32, and 35 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over U.S. Patent 6,219,409 to *Smith, et al.* in view of U.S. Patent 6,021,176 to *McKendry, et al.* and further in view of U.S. Patent 4,107,476 to *Henderson*.

The proposed combination of *Smith, McKendry, and Henderson*, however, “teaches away.” “A reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is improper to combine references where the references teach away from their combination.” M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The Office’s *prima facie* case requires impermissible changes to *Smith*’s principle of operation. The Office asserts that *Smith*’s “CPU Board 186 and PNI Communications Cards 187 collectively constitute a base unit.” Examiner Genack, Office Action mailed October 18, 2007, at page 2. The Office then proposes to combine *Smith*’s “base unit” with *McKendry*’s programmable personal call manager and with *Henderson*’s tone ringer. According to the

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Office, *Henderson's* tone ringer has a capacitor that charges to activate the tone ringer. *Henderson* explains that the tone ringer is an analog device that receives AC and DC inputs from a telephone line. See U.S. Patent 4,107,476 to *Henderson* at column 1, lines 55-57.

This proposed combination, however, impermissibly changes *Smith's* principle of operation. *Smith* utilizes a ring detection circuit to inform a microprocessor of a ring event. See, e.g., U.S. Patent 6,219,409 to *Smith, et al.* at column 12, lines 57-60. *Smith* then opens a switch to "prevent the telephone call from being transferred to the bus 185," which communicates with the CPU Board 186 and with the PNI Communications Cards 187. See *id.* at column 12, lines 60-65. See *also id.* at FIGS. 9 and 10. *Smith's* ring detection circuit, then, does not pass ring signals to the bus 185 for distribution to the PNIs 200. If *McKendry's* programmable personal call manager and/or *Henderson's* tone ringer are connected to *Smith's* circuitry, as the Office proposes, *Henderson's* tone ringer would not "[build] up a charge that generates a ring event on the telephone line" as independent claims 1 and 20 recite. Because *Smith* opens the switch 221 when a ring event is detected, ring signals would not pass onto the bus 185 and onto *Henderson's* tone ringer. The Office's proposed combination, then, would require at least eliminating *Smith's* switch 221.

Moreover, additional, impermissible changes are required. Independent claims 1 and 20 each recite "*the extension control device receiving power from a current on a telephone line.*" FIG. 11 of *Smith*, however, illustrates a processor-controlled "ring generator." The ring generator couples directly to the processor, and the processor receives power from a power supply. If *Henderson's* tone ringer were connected to *Smith's* circuitry, as the Office proposes, then *Smith's* processor-controlled "ring generator" would have to be changed to provide "*power from a current on a telephone line.*"

The proposed combination of *Smith, McKendry, and Henderson*, then, "teaches away" from their combination. *Smith* utilizes a ring detection circuit to detect a ring event. *Smith* then opens a switch to prevent ring signals from passing to bus. *Smith* then utilizes a processor-controlled ring generator. If *Smith* were modified with *McKendry* and *Henderson*, as the Office

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proposes, then *Smith's* circuitry must be changed and even eliminated for use with *Henderson's* tone ringer. The patent case law, however, prohibits changing a principle of operation to support a *prima facie* case. Because such changes are not permissible, any proposed combination of *Smith*, *McKendry*, and *Henderson* cannot support a *prima facie* case. The Office is thus respectfully requested remove the rejection of claims 1-3, 9, 12-15, 18-22, 26, 29-32, and 35.

Rejection of Claims 6-8 & 23-25 under § 103 (a)

Claims 6-8 and 23-25 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith* in view of *McKendry* and further in view of U.S. Patent 6,473,078 to Ikonen, *et al.*

Claims 6-8 and 23-25, however, cannot be obvious. Claims 6-8 and 23-25, respectively, depend from independent claims 1 and 20. These claims, then, incorporate the same distinguishing features. As the Office admits, both *Smith* and *McKendry* fail to teach or suggest at least "*the base unit communicating with the extension control device via a non-audio signal, the extension control device receiving power from a current on a telephone line, the extension control device building up a charge that generates a ring event on the telephone line.*"

The patent to Ikonen, *et al.* does not cure this deficiency. The patent to Ikonen, *et al.* discusses power management for a cathode ray tube display. The combined teaching of *Smith*, *McKendry*, and *Ikonen* still fails to teach or suggest the distinguishing features recited in independent claims 1 and 20 and incorporated into claims 6-8 and 23-25. Claims 6-8 and 23-25, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

Rejection of Claims 11, 16, 28 & 33 under § 103 (a)

Claims 11, 16, 28, and 33 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith* in view of *McKendry* and further in view of U.S. Patent 5,978,451 to Swan, *et al.*

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Claims 11, 16, 28, and 33, however, cannot be obvious. Claims 11, 16, 28, and 33, respectively, depend from independent claims 1 and 20. These claims, then, incorporate the same distinguishing features. As the Office admits, both *Smith* and *McKendry* fail to teach or suggest at least *"the base unit communicating with the extension control device via a non-audio signal, the extension control device receiving power from a current on a telephone line, the extension control device building up a charge that generates a ring event on the telephone line."*

The patent to *Swan, et al.* does not cure this deficiency. The patent to *Swan, et al.* discusses a personal communications controller for all the terminals in a residence. The combined teaching of *Smith*, *McKendry*, and *Swan* still fails to teach or suggest the distinguishing features recited in independent claims 1 and 20 and incorporated into claims 11, 16, 28, and 33. Claims 11, 16, 28, and 33, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

Rejection of Claims 10 & 27 under § 103 (a)

Claims 10 and 27 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith* in view of *McKendry* and further in view of U.S. Patent 6,823,354 to *Kynast, et al.*

Claims 10 and 27, however, cannot be obvious. Claims 10 and 27, respectively, depend from independent claims 1 and 20. These claims, then, incorporate the same distinguishing features. As the above paragraphs explained, *Smith* and *McKendry* both fail to teach or suggest at least *"the base unit communicating with the extension control device via a non-audio signal, the extension control device receiving power from a current on a telephone line, the extension control device building up a charge that generates a ring event on the telephone line."*

The patent to *Kynast, et al.* does not cure this deficiency. The patent to *Kynast, et al.* discusses a master station for a service provider. The combined teaching of *Smith*, *McKendry*, and *Kynast*, however, still fails to teach or suggest the distinguishing features recited in

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independent claims 1 and 20 and incorporated into claims 10 and 27. Claims 10 and 27, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

Rejection of Claims 17 & 34 under § 103 (a)

Claims 17 and 34 were rejected under 35 U.S.C. § 103 (a) as being allegedly obvious over *Smith* in view of *McKendry* and further in view of U.S. Patent 6,122,347 to Borland.

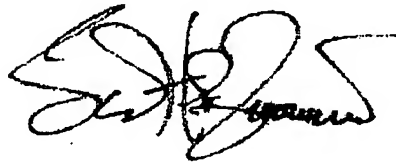
Claims 17 and 34, however, cannot be obvious. Claims 17 and 34, respectively, depend from independent claims 1 and 20. These claims, then, incorporate the same distinguishing features. As the above paragraphs explained, *Smith* and *McKendry* both fail to teach or suggest at least “the base unit communicating with the extension control device via a non-audio signal, the extension control device receiving power from a current on a telephone line, the extension control device building up a charge that generates a ring event on the telephone line.”

The patent to Borlan does not cure this deficiency. *Borland* discusses announcement of a caller before a ring is generated. The combined teaching of *Smith*, *McKendry*, and *Borland*, however, still fails to teach or suggest the distinguishing features recited in independent claims 1 and 20 and incorporated into claims 17 and 34. Claims 17 and 34, then, cannot be obvious, so Examiner Genack is respectfully requested to remove the § 103 (a) rejection of these claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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